

FAX

RECEIVED
CENTRAL FAX CENTER

SEP 05 2006

ATTN. Gautam Sain

Fax Number 1 571 273 8300

Phone Number 571 272 4096

FROM Volel Emile, Esq.

Fax Number 512 306 0240

Phone Number 512 306 7969

SUBJECT Substitute Appeal Brief 2 (09/997,915)

Number of Pages 19

Date 9/5/2006

MESSAGE

This fax communication contains:

1. one copy of a Fax Transmittal Form; and
2. one copy of the Substitute Appeal Brief 2.

Volel


SEP 05 2006


PTO/SB/21 (02-04)

Approved for use through 07/31/2006, OMR 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

TRANSMITTAL FORM <i>(to be used for all correspondence after initial filing)</i>	Application Number	09/97,815
	Filing Date	11/28/2001
	First Named Inventor	Bhupesh Gupta
	Art Unit	2176
	Examiner Name	Gautam Sain
Total Number of Pages in This Submission	Attorney Docket Number	AUS920010688US1

ENCLOSURES (Check all that apply)		
<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.63	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation <input type="checkbox"/> Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____	<input type="checkbox"/> After Allowance communication to Technology Center (TC) <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input type="checkbox"/> Other Enclosure(s) (please identify below): Supplemental Amendment
Remarks Substitute Appeal Brief		
SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT		
Firm or Individual name	Volei Emile	
Signature		
Date	09/05/2006	

CERTIFICATE OF TRANSMISSION/MAILING		
I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.		
Typed or printed name	Volei Emile	
Signature		Date
		09/05/2006

This collection of information is required by 37 CFR 1.6. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

SEP 05 2006

Appl. No. 09/997,915
Appeal Brief dated 09/05/2006
Reply to Office Action of 08/08/2006

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Application of:	:
Bhupesh Gupta	:
Serial No: 09/997,915	: Before the Examiner:
	: Gautam Sain
Filed: 11/29/2001	: Group Art Unit: 2176
Title: APPARATUS AND METHOD	: Confirmation No.: 6707
OF ORGANIZING BOOKMARKED	:
WEB PAGES INTO CATEGORIES	:

SUBSTITUTE APPEAL BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In a final Office Action dated August 25, 2005, the Examiner rejected the claims in this Application under 35 U.S.C. §102(b) as being anticipated by Burke. On December 11, 2005 Applicants appealed this decision. In an Office Action dated February 23, 2006, the Examiner reopened the Application's prosecution. In that Office Action, the Examiner rejected the claims under 35 U.S.C. §103(a) as being unpatentable over Burke in view of Li et al.

The Li et al. reference, according to the Examiner, is used to show that it is known to have bookmarks be automatically categorized based on the content of the documents they mark. As can be seen from the claims in the attached Claim Appendix, none of the claims recites the limitations of having bookmarks be automatically categorized based on the content of the documents they mark. Consequently, Applicants fail to see the relevance of the Li et al. reference in the continued prosecution of the present Application.

Therefore, Applicants request reinstatement of the Appeal.

AUS920010888US1

Page 1 of 17

Appl. No. 09/997,915
Appeal Brief dated 09/05/2006
Reply to Office Action of 08/08/2006

BRIEF FOR APPLICANTS - APPELLANTS

(i)

Real Party in Interest

The real party in interest is International Business Machines Corporation (IBM), the assignee.

(ii)

Related Appeals and Interferences

There are no other appeals or interferences known to appellants, appellants' representative or assignee, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(iii)

Status of Claims

Claims 1 – 33 are rejected under 35 U.S.C. §103 as being unpatentable over Burke in view of Li et al.

(iv)

Status of Amendment

All amendments have been entered.

(v)

Summary of Claimed Subject Matter

The Application contains four sets of claims of equal scope. The first set is a set of method claims (i.e., Claims 1 – 8), the second set is a set of computer program product claims (Claims 9 – 16), the third set is a set of apparatus claims (Claims 17 – 24) and the fourth is a set of system claims (Claims 25 – 32). The application also contains an additional claim (method Claim 33).

The present invention, as claimed in independent Claims 1, 9, 17, 25 and 33, provides a way of organizing bookmarked Web pages into categories. In
AUS920010888US1

Appl. No. 09/997,915
Appeal Brief dated 09/05/2006
Reply to Office Action of 08/08/2006

accordance with the teachings of the invention, when a Web page is being bookmarked, a check is made to determine whether the Web page to be bookmarked is assigned a category on a server. If so, the category is downloaded from the server. A sub-folder is then created with the downloaded category as a name and the bookmarked page is stored therein (see page 12, lines 13 to 23, page 15, lines 16 to 24 and page 15, line 27 to page 16, line 9 as well as Fig. 9).

The code means plus function of Claims 9 – 16 are the steps outlined on page 15, line 25 to page 16, line 9 as well as in Fig. 9. The means plus functions of Claims 17 – 24 are the steps outlined on page 15, line 25 to page 16, line 9 as well as in Fig. 9 processed by processors 202, 204 and 302.

(vi)

Grounds of Rejection to be Reviewed on Appeal

Whether Claims 1 - 33 were properly rejected under 103(a) as being unpatentable over Burke in view of Li et al.

(vii)

Arguments

It is a well settled law that in considering a Section §103 rejection, the subject matter of the claim "as a whole" must be considered and analyzed. In the analysis, it is necessary that the scope and contents of the prior art and differences between the art and the claimed invention be determined. *Graham v. John Deere Co.*, 383 U.S. 1 (1966).

Burke purports to provide a system for storing bookmark files in a remote location. According to Burke, a bookmark file that is stored on a local computer system (i.e., a system that is being used by a user) may also be stored remotely for anytime availability including when the local computer system is inoperative. When a bookmark file is being stored at the remote location by the user and if the user had already stored a bookmark file at the remote location, the bookmarks in

AUS920010888US1

Appl. No. 09/997,915
Appeal Brief dated 09/05/2006
Reply to Office Action of 08/08/2006

the file being stored and the bookmarks in the previously stored file may be merged together. The bookmarks in the bookmark file being stored may be stored in categories in which bookmarked pages from the previously stored bookmark file are stored. The categories may be in accordance with a master set of theme and topic codes. In this case, individual bookmarked pages from the file being stored will have been given a topic and theme code by the local system. After storing the bookmark file at the remote location, the user may at anytime download the bookmark file to any local system.

However, Burke does not teach, show or so much as suggest the step of ***determining whether a Web page to be bookmarked has been assigned a category on a server.***

The Examiner stated that in col. 4, line 65 to – col. 5, line 20 Burke does teach this claimed element. Applicants have to disagree.

In col. 4, line 65 to col. 5, line 7 it is stated that "[i]n the exemplary embodiment the received file is an HTML file and controller 40 identifies individual URL address codes within the received file by parsing the file contents in order to identify HTML tags (e.g. Href tags) that identify HTML statements as URL address codes. Controller 40 also identifies the format type of the address codes in the received file from indicators in the transferred file. The transferred file may contain address codes types in Netscape Navigator.TM., or Microsoft Explorer.TM. type formats, for example."

In col. 5, lines 8 – 24 it is stated that "[i]n step 320, controller 40 collates both the bookmarks in the received file and bookmarks previously stored in a User designated file within storage system 15 to form a single merged set of bookmarks. Controller 40, in step 320, collates the bookmarks by categorizing the bookmarks by theme and topic. A bookmark theme e.g. Finance, encompasses the sub-category of topic e.g. different stock price services such as stockmaster.com.TM. or Yahoo.finance.COM.TM. Such a collation scheme may also categorize the bookmarks by allocation of different folders or file groups for containing bookmarks of different theme and topic. In addition, bookmarks may

AUS920010888US1

Appl. No. 09/997,915
Appeal Brief dated 09/05/2006
Reply to Office Action of 08/08/2006

be collated in accordance with a master set of theme and topic codes. In this case, individual bookmarks are allocated a topic and theme code and controller 40 collates the bookmarks according to the master set of codes contained in internal memory of system 15."

As can be seen from the above-quoted passages, nowhere is there a hint of a server being checked to see whether it has a category for a Web page. Rather, it is stated that each individual bookmark from the bookmark file that has been received has a topic and a theme code to help facilitate its categorization. The categorization is done in accordance with a stored master set of codes.

Thus, Burke does not teach, show or so much as suggest the step of ***determining whether a Web page to be bookmarked has been assigned a category on a server.***

Further, Burke does not teach the step of ***downloading the category if the Web page has been assigned a category.***

The Examiner stated that in col. 5, lines 8 – 24 and col. 7, lines 10 – 15 Burke teaches this step. Again, Applicants have to disagree.

In a passage in col. 5, lines 8 – 24, which has been reproduced above, it is stated that "[c]ontroller 40, in step 320, collates the bookmarks by categorizing the bookmarks by theme and topic. A bookmark theme e.g. Finance, encompasses the sub-category of topic e.g. different stock price services such as stockmaster.com.TM. or Yahoo.finance.COM.TM."

Thus, Burke discloses an example of a theme (i.e., finance) and an example of a topic that may fall under the theme (i.e., different stock price services). As an example of different stock price services, Burke refers the reader to stockmaster.com.TM or Yahoo.finance.COM.TM. But nowhere in that passage does Burke ***teach that a category is downloaded if the Web page is not assigned one.*** Nor would there be any reason for Burke to show this step since Burke specifically teaches that the bookmarked pages from the received file have each a theme and topic by which they are to be categorized.

AUS920010888US1

Appl. No. 09/997,915
Appeal Brief dated 09/05/2006
Reply to Office Action of 08/08/2006

In col. 7, lines 10 – 15 It is stated that "[I]n this mode, controller 40 responds to the communication from controller 30 by downloading the identified User designated bookmark address file stored within system 15 to terminal 10. Further, in step 415 controller 30 establishes integrated transparent access by the User at terminal 10 to the downloaded bookmark file transferred from system 15."

Clearly, in this passage it is not disclosed that Burke teaches the step of ***downloading the category if the Web page has been assigned a category.***

Since Burke does not teach the step of ***determining whether a Web page to be bookmarked has been assigned a category on a server and the step of downloading the category if the Web page has been assigned a category***, then there is no reason for Burke to show the steps of ***creating a sub-folder in the bookmark folder with the category as a name; and storing a bookmark to the Web page into the sub-folder*** and indeed does not.

Note also that the limitations of Claims 5 and 6 are not taught by Burke. That is, Burke does not teach that if the Web page has not been assigned a category, a note is sent to an administrator of the server requesting that the Web page be assigned a category (see Claims 5). Neither does Burke teach that after the Web page has been assigned a category, the category and the URL of the Web page are downloaded wherein the downloaded category is used as a name to a sub-folder into which the bookmark to the Web page is to be moved and the URL is used to differentiate the Web page from other Web pages that may be in the default sub-folder (see Claim 6).

As mentioned above, the other applied reference (i.e., Li et al.) is used to show that it is known to have bookmarks be automatically categorized based on the content of the documents they mark but not to show any of the emboldened/italicized element of the claims. Since Li et al. is not used to show any of the claimed elements that are not shown by Burke, combining the teachings of Burke with those of Li et al. will not show the claimed invention.

AUS920010888US1

Appl. No. 09/997,915
Appeal Brief dated 09/05/2006
Reply to Office Action of 08/08/2006

Hence, Applicants submit that the claims are allowable over the applied references. Therefore, Applicants once more respectfully request reconsideration, allowance and passage to issue of the claims in the application.

Respectfully Submitted

By: 

Volet Emile
Attorney for Applicants
Registration No. 39,969
(512) 306-7969

AUS920010888US1

Page 7 of 17

Appl. No. 09/997,915
Appeal Brief dated 09/05/2006
Reply to Office Action of 08/08/2006

(viii)

Claims Appendix

1. (Previously presented) A computer implemented method of categorizing bookmarked Web pages in a bookmark folder comprising the steps of:

determining whether a Web page to be bookmarked has been assigned a category on a server;

downloading the category if the Web page has been assigned a category;

creating a sub-folder in the bookmark folder with the category as a name;
and

storing a bookmark to the Web page into the sub-folder.
2. (Previously presented) The computer implemented method of Claim 1 further including the step of determining whether there already exists a sub-folder with the category as a name before creating the sub-folder.
3. (Previously presented) The computer implemented method of Claim 2 wherein if there already exists a sub-folder with the category as a name, the bookmark to the Web page is stored into the already existed sub-folder and the sub-folder is not created.
4. (Previously presented) The computer implemented method of Claim 1 wherein if the Web page has not been assigned a category, the Web page is stored into a default sub-folder.

AUS920010888US1

Appl. No. 09/997,915
Appeal Brief dated 09/05/2006
Reply to Office Action of 08/08/2006

5. (Previously presented) The computer implemented method of Claim 4 wherein if the Web page has not been assigned a category, a note is sent to an administrator of the server requesting that the Web page be assigned a category.
6. (Previously presented) The computer implemented method of Claim 5 wherein after the Web page has been assigned a category, the category and the URL of the Web page are downloaded wherein the downloaded category is used as a name to a sub-folder into which the bookmark to the Web page is to be moved and the URL is used to differentiate the Web page from other Web pages that may be in the default sub-folder.
7. (Previously presented) The computer implemented method of Claim 6 further including the step of determining whether there already exists a sub-folder with the category as a name in the bookmark folder before creating the sub-folder.
8. (Previously presented) The computer implemented method of Claim 7 wherein if there already exists a sub-folder with the category as a name, a sub-folder is not created and the bookmark to the Web page is moved into the already existed sub-folder.
9. (Previously presented) A computer program product on a computer readable medium for categorizing bookmarked Web pages in a bookmark folder comprising:

code means for determining whether a Web page to be bookmarked has been assigned a category on a server;

AUS920010888US1

Appl. No. 09/997,915
Appeal Brief dated 09/05/2006
Reply to Office Action of 08/08/2006

code means for downloading the category if the Web page has been assigned a category;

code means for creating a sub-folder in the bookmark folder with the category as a name; and

code means for storing a bookmark to the Web page into the sub-folder.

10. (Original) The computer program product of Claim 9 further including code means for determining whether there already exists a sub-folder with the category as a name before creating the sub-folder.
11. (Original) The computer program product of Claim 10 wherein if there already exists a sub-folder with the category as a name, the bookmark to the Web page is stored into the already existed sub-folder and the sub-folder is not created.
12. (Original) The computer program product of Claim 9 wherein if the Web page has not been assigned a category, the bookmark to the Web page is stored into a default sub-folder.
13. (Original) The computer program product of Claim 12 wherein if the Web page has not been assigned a category, a note is sent to an administrator of the server requesting that the Web page be assigned a category.
14. (Original) The computer program product of Claim 13 wherein after the Web page has been assigned a category, the category and the URL of the Web page are downloaded wherein the downloaded category is used as a name to a sub-folder into which the bookmark to the Web page is to be

AUS920010888US1

Appl. No. 09/997,915
Appeal Brief dated 09/05/2006
Reply to Office Action of 08/08/2006

moved and the URL is used to differentiate the Web page from other Web pages that may be in the default sub-folder.

15. (Original) The computer program product of Claim 14 further including code means for determining whether there already exists a sub-folder with the category as a name in the bookmark folder before creating the sub-folder.
16. (Original) The computer program product of Claim 15 wherein if there already exists a sub-folder with the category as a name, a sub-folder is not created and the bookmark to the Web page is moved into the already existed sub-folder.
17. (Previously presented) A computer implemented apparatus for categorizing bookmarked Web pages in a bookmark folder comprising:

means for determining whether a Web page to be bookmarked has been assigned a category on a server;

means for downloading the category if the Web page has been assigned a category;

means for creating a sub-folder in the bookmark folder with the category as a name; and

means for storing a bookmark to the Web page into the sub-folder.
18. (Previously presented) The computer implemented apparatus of Claim 17 further including means for determining whether there already exists a sub-folder with the category as a name before creating the sub-folder.

AUS920010888US1

Appl. No. 09/997,915
Appeal Brief dated 09/05/2006
Reply to Office Action of 08/08/2006

19. (Previously presented) The computer implemented apparatus of Claim 18 wherein if there already exists a sub-folder with the category as a name, the bookmark to the Web page is stored into the already existed sub-folder and the sub-folder is not created.
20. (Previously presented) The computer implemented apparatus of Claim 17 wherein if the Web page has not been assigned a category, the bookmark to the Web page is stored into a default sub-folder.
21. (Previously presented) The computer implemented apparatus of Claim 20 wherein if the Web page has not been assigned a category, a note is sent to an administrator of the server requesting that the Web page be assigned a category.
22. (Previously presented) The computer implemented apparatus of Claim 21 wherein after the Web page has been assigned a category, the category and the URL of the Web page are downloaded wherein the downloaded category is used as a name to a sub-folder into which the bookmark to the Web page is to be moved and the URL is used to differentiate the Web page from other Web pages that may be in the default sub-folder.
23. (Previously presented) The computer implemented apparatus of Claim 22 further including code means for determining whether there already exists a sub-folder with the category as a name in the bookmark folder before creating the sub-folder.
24. (Previously presented) The computer implemented apparatus of Claim 23 wherein if there already exists a sub-folder with the category as a name, a

AUS920010888US1

Appl. No. 09/997,915
Appeal Brief dated 09/05/2006
Reply to Office Action of 08/08/2006

sub-folder is not created and the bookmark to the Web page is moved into the already existed sub-folder.

25. (Previously presented) A computer system for categorizing bookmarked Web pages in a bookmark folder comprising:

at least one memory device for storing code data; and

at least one processor for processing the code data to determine whether a Web page to be bookmarked has been assigned a category on a server, to download the category if the Web page has been assigned a category, to create a sub-folder in the bookmark folder with the category as a name and to store a bookmark to the Web page into the sub-folder.

26. (Original) The computer system of Claim 25 wherein the processor processes the code data to further determine whether there already exists a sub-folder with the category as a name before creating the sub-folder.

27. (Original) The computer system of Claim 26 wherein if there already exists a sub-folder with the category as a name, the bookmark to the Web page is stored into the already existed sub-folder and the sub-folder is not created.

28. (Original) The computer system of Claim 25 wherein if the Web page has not been assigned a category, the bookmark to the Web page is stored in a default sub-folder.

29. (Original) The computer system of Claim 28 wherein if the Web page has not been assigned a category, a note is sent to an administrator of the server requesting that the Web page be assigned a category.

AUS920010888US1

Appl. No. 09/997,915
Appeal Brief dated 09/05/2006
Reply to Office Action of 08/08/2006

30. (Original) The computer system of Claim 29 wherein after the Web page has been assigned a category, the category and the URL of the Web page are downloaded wherein the downloaded category is used as a name to a sub-folder into which the bookmark to the Web page is to be moved and the URL is used to differentiate the Web page from other Web pages that may be in the default sub-folder.
31. (Original) The computer system of Claim 30 wherein the processor processes the code data to further determine whether there already exists a sub-folder with the category as a name in the bookmark folder before creating the sub-folder.
32. (Original) The computer system of Claim 31 wherein if there already exists a sub-folder with the category as a name, a sub-folder is not created and the bookmark to the Web page is moved into the already existed sub-folder.
33. (Previously presented) A computer implemented method of categorizing bookmarked Web pages in a bookmark folder on a local computer system comprising the steps of:

determining whether a Web page is to be bookmarked on the local computer system;

determining, if the Web page is to be bookmarked, whether the Web page has been assigned a category on a remote computer system;

downloading the category if the Web page has been assigned a category;

AUS920010888US1

Appl. No. 09/997,915
Appeal Brief dated 09/05/2006
Reply to Office Action of 08/08/2006

determining whether the downloaded category already exists as a name of a sub-folder in the bookmark sub-folder on the local computer system;

storing, if the downloaded category already exists as a name of a sub-folder in the bookmark sub-folder on the local computer system, a bookmark to the Web page into the sub-folder;

creating, if the downloaded category does not already exist as a name of a sub-folder in the bookmark sub-folder on the local computer system, a sub-folder in the bookmark folder on the local computer system with the downloaded category as a name for the sub-folder; and

storing the bookmark to the Web page into the created sub-folder.

AUS920010888US1

Appl. No. 09/997,915
Appeal Brief dated 09/05/2006
Reply to Office Action of 08/08/2006

(lx)

Evidence Appendix

No evidence was submitted pursuant to 37 C.F.R. §§ 1.130, 1.131 and 1.132 nor was there any evidence entered by the Examiner relied upon by Appellants in this appeal.

AUS920010888US1

Page 16 of 17

Appl. No. 09/997,915
Appeal Brief dated 09/05/2006
Reply to Office Action of 08/08/2006

(x)

Related Proceedings Appendix

There are no decisions rendered by a court or the Board that would have a bearing on the Board's decision in the pending appeal.

AUS920010888US1

Page 17 of 17